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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/835,064

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Giovanni Giuffrida

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TOPE-MCKAY & ASSOCIATES

23852 PACIFIC COAST HIGHWAY #311

MALIBU, CA 90265

EXAMINER

ABEL JALIL, NEVEEN

ART UNIT

PAPER NUMBER

2165

MAIL DATE

DELIVERY MODE

08/21/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/835,064	Applicant(s) GIUFFRIDA ET AL.	
	Examiner Neveen Abel-Jalil	Art Unit 2165	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 27-May -2008 has been entered.

2. The response filed on 27-May -2008 has been received and entered. Claims 1-16 are pending.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-2, 4-10, and 12-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Copperman et al. (U.S. Patent No. 6,711,585 B1).

As to claims 1, and 9, Copperman et al. discloses an apparatus for automatically extracting metadata from electronic documents comprising a first processing element, a second processing element, a reasoning element, and a database, wherein,

- i) said first processing element is further configured to convert electronic documents into files (See column 12, lines 62-67, also see abstract);
- ii) said first processing element is configured to provide the files to a second processing element (See column 18, lines 7-10, and see column 18, lines 44-48);
- iii) said second processing element is configured to receive said files and extract predetermined information (See column 2, lines 21-24);
- iv) said second processing element is further configured to provide said extracted predetermined information to said reasoning element (See column 2, lines 25-31);
- v) said database is configured to also provide input to said reasoning element (See column 13, lines 1-10);
- vi) said reasoning element is configured to employ a set of rules to automatically extract metadata from the files by employing the extracted predetermined information and the input from the database (See column 12, lines 45-51, also see column 13, lines 37-63, wherein “reasoning element” is the processing and analysis done by the “autocontextualization”); and
- vii) reasoning element provides an output of metadata (See Figure 22).

As to claims 2, and 10, Copperman et al. discloses an apparatus for automatically extracting metadata from electronic documents, wherein said files are substantially format invariant data files (See column 12, lines 62-67).

As to claims 4, and 12, Copperman et al. discloses wherein the second processing element and said database simultaneously input to the reasoning element (See Figure 5, 510, column 9, lines 38-58).

As to claims 5, and 13, Copperman et al. discloses wherein said set of rules is updated (See column 16, lines 1-13).

As to claims 6, and 14, Copperman et al. discloses wherein said metadata is substantially comprised of title, author, affiliation, author affiliation, and table of contents (See Figure 2, and see column 13, lines 41-50).

As to claims 7, and 15, Copperman et al. discloses wherein said metadata is provided to a user interface (See Figure 21).

As to claims 8, and 16, Copperman et al. discloses wherein said metadata is provided to a storage medium (See Figure 2, also see column 18, lines 44-48).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 3, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Copperman et al. (U.S. Patent No. 6,711,585 B1) in view of Lang and M. Burnett. *Knowledge-Based Systems. XML, metadata and efficient knowledge discovery*. Pub. 2000. Elsevier Science B.V. (from hereon in Lang et al.)

Copperman et al. teaches the claimed invention but does not explicitly teach wherein said predetermined information is substantially spatial layout facts. However, Copperman et al. teaches maintaining and considering topical distance relationships as well as boundaries of the original document (See Copperman et al. column 16, lines 41-59).

Lang et al. teaches extracting special layout facts (See Lang et al. page 327).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Copperman et al. by the teaching of Lang et al. to include wherein said predetermined information is substantially spatial layout facts because it provides for accurate document presentation to the users (See Lang et al. Page 324).

Response to Amendment

7. The Declaration filed on May 27, 2008 under 37 CFR 1.131 has been considered but is ineffective to overcome the Copperman (Patent No. 6,711,585 B1) reference.

The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Copperman reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete

disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897). There is no establishment of dates as to proof conception. The document submitted by the Applicant is only sufficient to show the year 2000 dates. Although, it mentions a start date of Jan. 1999 on sheet 2, it is signed and dated beginning with Jan. 2000. A document created and signed a year later is not sufficient to show Jan. 1999 date. The current applied Copperman reference claims priority to June 15, 1999 prior to the submitted evidence date. While, the Applicant is claiming conception to Jan. 1999, therefore document from the claimed timeframe needs to be submitted as evidence.

The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Copperman reference to either a constructive reduction to practice or an actual reduction to practice.

In accordance with MPEP section 715 Three ways to show prior invention:

Where there has not been reduction to practice prior to the date of the reference, the applicant or patent owner must also show diligence in the completion of his or her invention from a time just prior to the date of the reference continuously up to the date of an actual reduction to practice or up to the date of filing his or her application (filing constitutes a constructive reduction to practice, 37 CFR 1.131).

Not only is diligence not established by any showing or evidence or proof of continuous work relative to the invention. Since the inventors are unavailable, the assignee must hold some concept paper or email trail or product requirements paper to proof conception and diligence. Instead, Assignee's general counsel is taking the burden of lack of due diligence by mere allegation of general statement made in the affidavit, however such statement alone is

Art Unit: 2165

insufficient to show diligence because no proof was provided that the applicant had in fact submitted the document to the attorney at the date specified. Furthermore, General council statement was made in the remarks not in the affidavit itself. Diligence needs to be shown as part of the affidavit.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. For cited art, see PTO-form 892.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neveen Abel-Jalil whose telephone number is 571-272-4074. The examiner can normally be reached on 8:30AM-5:30PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christian P. Chace can be reached on 571-272-4190. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Neveen Abel-Jalil
Primary Examiner
August 18, 2008
/Neveen Abel-Jalil/

Primary Examiner, Art Unit 2165